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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,227	01/08/2002	Bernd Riedl	BAYER 15(1)	5714

23599      7590      01/17/2003

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EXAMINER

DESAI, RITA J

ART UNIT      PAPER NUMBER

1625

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

<b>Application No.</b> 09/889,227	<b>Applicant(s)</b> RIEDL ET AL.	
<b>Examiner</b> RITA J. DESAI	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on \_\_\_\_\_ .
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-67 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-67 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \*   c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_ .

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**DETAILED ACTION**

Claims 1-67 in part drawn to group IV are pending.

***Priority***

Applicants priority to US 09/425228 filed 10/22/1999 is being acknowledged.

***Election/Restrictions***

Applicants traversal of the restriction is acknowledged but not found convincing.

Applicants compounds are all made of variables except for the NH-C=O-NH group . is -NH-CO-NH. (urea). This common core of the applicant is also very common . A search done on just this core gave >

SAMPLE SEARCH INITIATED 16:32:25 FILE 'REGISTRY'

SAMPLE SCREEN SEARCH COMPLETED - 19990 TO ITERATE

5.0% PROCESSED 1000 ITERATIONS 50 ANSWERS

INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)

SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS: ONLINE \*\*INCOMPLETE\*\*

BATCH \*\*COMPLETE\*\*

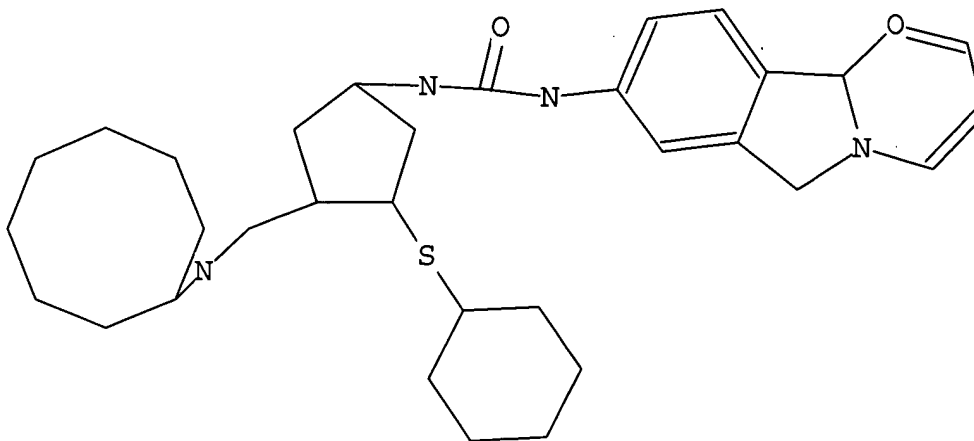
PROJECTED ITERATIONS: 391366 TO 408234

PROJECTED ANSWERS: 190768 TO 202634

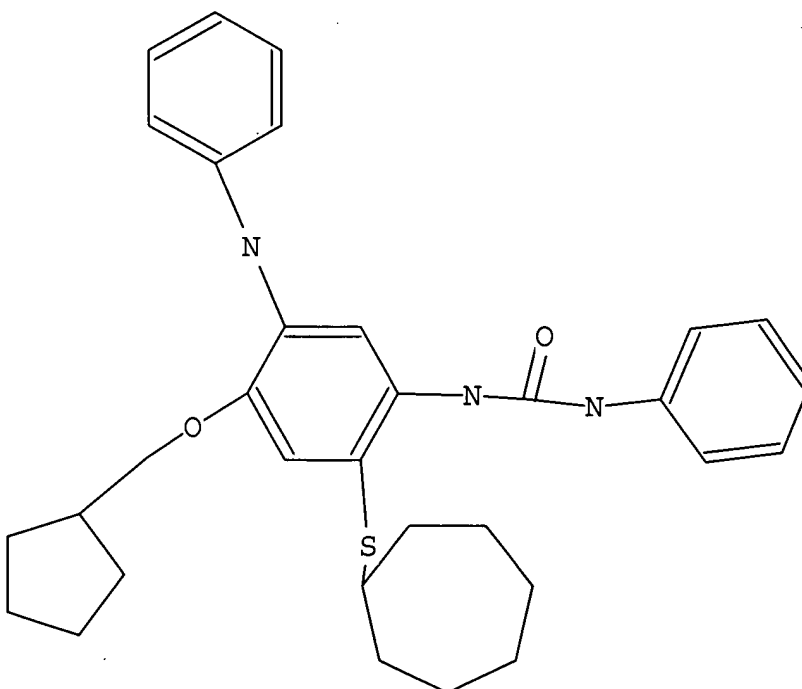
NH-CO-NH

This indicated that

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and



would both fall within

the same group of compounds!!

Applicant 's traverse on the grounds that the inventions are not patentably distinct, applicants have not submitted evidence or identified such evidence showing the groups to be obvious variants and have not clearly admitted on the record that this is the case.

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The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Scope of enablement**

Claims 1, 18-21, 33, 35 -39 , 48, 49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for some substituents as enabled in the tables, does not reasonably provide enablement for any organic compounds with 1-40 C atoms or 1-24 carbon atoms which may have hetero atoms selected from O, S, N!! . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims without any undue experimentation.

In re Wands , 858 F. 2d 731,737,8 USPQ@d 1400, 1404 (Fed. Cir. 1988). Ex Parte Forman, 230 USPQ 546 (Bd of App. 1986).

The general description of the organic compounds for all the A, Ra, Rb , Rx , Rz , R7 and R's and W encompasses a huge category of compounds and since these are compounds used for pharmaceutical use , the predictability of it working is very low.

Thus one would have to perform undue experimentation to obtain the compounds of the invention.!

Claims 1, 18-21, 33, 35 -39 , 48, 49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is a lack of written description in the specifications of the types of groups defined by C1-C40, C1-C24 optionally containing heteroatoms such as S, O N.!

Applicants can overcome this by limiting the claims to the groups in the tables.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 60 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Ex parte Fressola 27 USPQ 2d 1608.

A claim should be complete in itself and should not refer to the specifications or tables.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of copending Application No. 09/948,915. Although the conflicting claims are not identical, they are not patentably distinct from each other because they have a overlapping genus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822 or file a terminal disclaimer.

Art cited US 5447957 Adams et al. The reference teaches similar compounds but the substitution the L' is different.

### ***Conclusion***

The claims 1-67 are not allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A handwritten signature in cursive script that reads "R. Desai". The signature is written in black ink and is positioned above a horizontal line.

R.D.

January 10, 2003